

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERUYUKI MATSUMURA, SATORU SHINOZAKI, TAKAHIKO ENDO

Appeal No. 1997-1924
Application No. 08/244,633

ON BRIEF

Before, FLEMING, RUGGIERO and HECKER, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claim 1. Claims 2 and 3 have been indicated as allowable.

Appellants' invention relates to a machining program checking method for a numerical control (NC) device; more particularly, for a program checking method for an NC turret

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lathe having a plurality of tools (one active) mounted thereon. This program simulates movement of the turret having a plurality of tools, to check for interference between the tools, the workpiece and various parts of the NC lathe.

Claim 1 is reproduced as follows:

1. A machining program checking method for a numerical control device which controls an NC lathe having a turret for carrying a plurality of tools thereon, comprising the steps of:

(a) obtaining a relationship of relative position between a tool specified to be a tool in use by a machining program and each of other tools mounted on the turret;

(b) simulating movement of each of said tools in accordance with the relationship of relative position obtained in said step (a), the machining program, and mounting data of each of said tools; and

(c) detecting interference of each of said other tools mounted on the turret with a workpiece, and interference of each of said other tools with various parts of the NC lathe.

The reference relied on by the Examiner is as follows:

Kawamura et al.	5,079,713	Jan. 07, 1992
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Claim 1 stands rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Kawamura.

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Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief, reply brief and the answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claim 1 is anticipated under 35 U.S.C. § 102(e) by Kawamura.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." ***RCA Corp. v. Applied Digital Data Systems, Inc.***, 730 F.2d 1440, 1444, 221

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USPQ 385, 388 (Fed. Cir. 1984), *cert. dismissed*, 468 U.S. 1228 (1984), *citing Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Appellants argue on page 5 of the brief that Kawamura does not disclose checking the interference between each of the tools other than the tool currently in use on the turret and a workpiece, and the interference between each of the other tools and various parts of the NC lathe. We note that these limitations are recited in Appellants' claim 1 step (c).

The Examiner responds that Kawamura is applicable to preventing collisions between "movable members" of the machine tool. This implies that interference is detected and corrected not only with respect to the tools but also with the workpiece and various other parts of the NC machine tool (answer-page 5). The Examiner further states:

[t]he entire argument [of Appellants] suggests that each and every detail of the claimed invention must be explicitly disclosed in the reference and if not the claim is deemed patentable. This premise

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ignores the understanding of how any system really operates. There are some details about any system which are implicit by nature and may not be absolutely specified in any part of the system's description....Kawamura et al. implicitly comprises knowledge about where each tool is positioned or there would be no way of detecting tool interference in the system. (Answer-page 5.)

"Inherency and obviousness are distinct concepts." **W. L. Gore & Associates, Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1555,

220 USPQ 303, 314 (Fed. Cir. 1983) citing **In re Spormann**, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." **Continental Can Co. v. Monsanto Co.** 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency,

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however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

recognized by a person of ordinary skill.'" *In re Robertson*, Slip Op 98-1270 (Fed. Cir. February 25, 1999) *citing* *Continental Can Co. v. Monsanto Co.*, 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

The Examiner has presented no extrinsic evidence of inherency, or how Kawamura implicitly comprises knowledge about where each tool is positioned, specifically the other tools not in use. We have reviewed Kawamura to determine the

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scope of the "movable members" relied upon by the Examiner. The only movable members found are tool rests TP1 and TP2. However, these represent tools **in use**, as opposed to tools **not in use**. We find nothing in Kawamura that implicitly teaches detecting interference of the claimed "other tools" (i.e., tools not in use), nor do we find any basis for detecting interference with various parts of the NC lathe as claimed. Additionally, the Examiner has not shown, nor do we find in Kawamura, other tools **not in use** and mounted on the **same turret** as the tool in use. Thus, the Examiner has not shown anticipation of the claim by Kawamura.

In view of the foregoing, the decision of the Examiner rejecting claim 1 under 35 U.S.C. § 102(e) is reversed.

REVERSED

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	MICHAEL R. FLEMING)	
	Administrative Patent Judge)	
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PATENT)	
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